

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Honduras

Civil and administrative procedures and remedies

(a) Civil judicial procedures and remedies

1. Specify the courts which have jurisdiction over IPR infringement cases.

The civil judicial authorities which have jurisdiction and competence in property matters are:

- Ordinary civil courts I, II, III and IV;
- civil magistrates' courts;
- Court of Appeal;
- Supreme Court of Justice.

The applicable provisions in respect of civil actions instituted against acts of unfair competition are Articles 160 first paragraph, 163 first paragraph, 165, 166 and 169 of the Industrial Property Law and Articles 173 to 178 and 183 of the Law on Copyright and Related Rights.

The relevant provisions of the Commercial Code and the Civil Code relating to unlawful acts are also applicable.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

Which persons have standing to assert IPRs?

Natural and legal persons with a legitimate interest may apply to the competent authorities.

How may they be represented?

Through their legal representative or authorized agent.

Are there requirements for mandatory personal appearances before the court by the right holder?

¹ Document IP/C/5.

Personal appearances before the court by the right holder are not mandatory because he/she is served by a legal representative or authorized agent. Article 4 of the Code of Civil Procedure is applicable.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

The competent authorities may require the parties and third parties to produce evidence which lies within their control, provided that such evidence serves to clarify the matter at issue.

Articles 262 and 300 to 409 of the Code of Civil Procedure and Article 165 of the Industrial Property Law are applicable.

4. What means exist to identify and protect confidential information brought forward as evidence?

In any civil judicial proceedings where any of the parties or third parties is required to disclose confidential information, the authority dealing with the case must take the action necessary to prevent the rights of the interested parties from being infringed.

Articles 111 and 222 subparagraph 3 of the Law on the Organization and Jurisdiction of the Courts (LOAT) and Article 165 of the Industrial Property Law are applicable.

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- **Injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Injunctions

Injunctions take the form of decrees (*decretos*), orders (*autos*) or rulings (*providencias*), resolutions (*resoluciones*) or judgements (*sentencias*): decrees if they relate to mere procedural findings; orders or rulings when they decide any point in a case under consideration, and resolutions or judgements when they bring closure to a proceeding or trial in a court or in special appeal proceedings. Such injunctions may require a party or a third party to the proceedings to act in a particular manner or to engage in specified conduct.

Articles 183 to 196 of the Code of Civil Procedure are applicable.

Damages, including recovery of profits, and expenses, including attorney's fees

If the court awards damages, it will fix the amount or establish arrangements for payment.

The court's decision may contain an order for the payment of legal expenses.

The applicable provisions are Articles 1351, 1357 subparagraph 3, 1360, 2236 and 2237 of the Civil Code, Articles 164 and 165 of the Industrial Property Law and Article 175 of the Law on Copyright and Related Rights.

Destruction or other disposal of infringing goods and materials/implements for their production

The court may include in its decision a measure entailing *inter alia* the destruction of goods, the definitive seizure of implements and materials for the storage of copies and other items.

The provisions applicable to precautionary measures are Article 169 of the Industrial Property Law and Article 177 of the Law on Copyright and Related Rights.

Any other remedies

In its decision, the competent court may order any measure it deems appropriate, provided that it is in conformity with the law.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

The civil judicial authorities have all the powers conferred on them by the Law and may order the infringer to identify any person, object or document, whether belonging to the parties or to a third party, in order to determine their legal status in the dispute; such evidence must be admissible under the Law and closely connected with the disputed facts.

Articles 338, 340 and 343 of the Code of Civil Procedure are applicable.

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

Any defendant who has been wrongfully enjoined may submit a counterclaim when contesting the injunction.

The court is required to allow the counterclaim and to deal with it in a single ruling.

As far as the responsibility of the public authorities is concerned, public officials may be liable to sanctions such as imprisonment, suspension, indemnification or initiation of court proceedings.

The applicable provisions are Articles 324 and 325 of the Constitution of the Republic, Article 349 of the Civil Code and Articles 120 to 136, 1351, 1357 subparagraph 3 and 1360 of the Law on the Organization and Jurisdiction of the Courts (LOAT).

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The duration and cost of proceedings vary according to the complexity of the case concerned.

Proceedings may be conducted by means of an enforcement action or an ordinary action.

(b) Administrative procedures and remedies

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

9.1 Specify the (courts) administrative offices which have jurisdiction over IPR infringement cases.

The administrative authorities are:

- The Ministry of Industry and Trade through the Directorate General for Intellectual Property;
- the Ministry of Agriculture, Seed Certification Department of the Directorate General of the National Agricultural Health Service (SENASA);
- the Executive Revenue Directorate (DEL);
- the State Prosecution Service;
- the Ministry of Security;
- CONATEL.

The applicable provisions are Article 156 of the Law on Copyright, Articles 158 to 173 of the Industrial Property Law and Article 45 of the Law on New Plant Varieties.

9.2 Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before (the court) an administrative office by the right holder.

Which persons have standing to assert IPRs?

Natural and legal persons with a legitimate interest may apply to the competent authorities.

How may they be represented?

Through their legal representative or authorized agent.

Are there requirements for mandatory personal appearances before (the court) an administrative office by the right holder?

There is no mandatory requirement for the right holder to appear in person before the court, as this can be done by his/her legal representative or agent.

Articles 54 to 56 and 59 of the Law on Administrative Procedure are applicable.

9.3 What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

The competent authorities may require the parties and third parties to produce evidence which lies within their control, provided that such evidence serves to clarify the matter at issue.

When the injured right holder or the alleged infringer denies access to evidence or does not produce relevant evidence under his/her control within a reasonable period, or substantially impedes the proceeding.

Articles 69 and 72 of the Law on Administrative Procedure are applicable.

9.4 What means exist to identify and protect confidential information brought forward as evidence?

In any judicial or administrative proceedings where an interested party is required to reveal a secret, the authority dealing with the case shall adopt the necessary measures to prevent its disclosure to third parties unconcerned by the dispute.

Articles 69 and 150 of the Law on Administrative Procedure are applicable.

9.5 Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- Injunctions;
- damages, including recovery of profits, and expenses, including attorney's fees;
- destruction or other disposal of infringing goods and materials/implements for their production;
- any other remedies.

Injunctions

Administrative injunctions take the form of decrees, decisions, resolutions and rulings.

Administrative injunctions concerning the violation of any of the rights protected by the intellectual property laws may:

- Order the withdrawal from circulation of infringing goods;
- prohibit, with immediate effect, the marketing of products serving to violate any of the rights protected (seizure, attachment, deposit);
- order the confiscation of goods;
- order suspension of service provision or closure of the establishment.

The applicable provisions are Article 13 of the Law on Administrative Procedure and Articles 116 to 118 of the General Law on Public Administration.

Damages, including recovery of profits, and expenses, including attorney's fees

Anyone injured by a violation of intellectual property rights may claim damages and compensation for material injury from the person or persons responsible for the violation.

If the seized goods are insufficient to cover the amount stipulated, the measure may be extended to other goods and the costs shall be borne by the obligor in accordance with the procedure.

The applicable provisions are Article 102 of the Code of Administrative Procedure, Article 47 of the Law on New Plant Varieties, Article 175 of the Law on Copyright and Articles 159, 164 and 165 of the Industrial Property Law.

Destruction or other disposal of infringing goods and materials/implements for their production

Where such material exists, it shall be handed over to the judicial authorities for use as evidence, and the competent authority may order its destruction in a final decision.

Article 163, subparagraphs 3 and 7, of the Industrial Property Law is applicable.

Any other remedies

Fines, closure of establishments and seizure of goods.

The applicable provisions are Article 110 of the Code of Administrative Procedure, Articles 156 and 157 of the Law on Copyright and Article 167 of the Industrial Property Law.

9.6 In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

The administrative authorities have no authority to order the infringer to provide information about the identity of third persons involved in the production of infringing goods or services, except through judicial organs.

The administrative authorities may order the suspension of service provision or closure of the establishment if the measures specified in the previous reply are not sufficient to forestall or prevent violation of the rights protected by the industrial property laws.

Articles 338, 340 and 343 of the Code of Civil Procedure and Articles 22 to 235 of the Code of Criminal Procedure are applicable.

9.7 Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

The administrative authorities are responsible for the measures ordered.

Article 124 of the Law on Public Administration is applicable.

See the reply to question 7 above.

9.8 Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The duration and cost of proceedings vary according to the complexity of the case concerned.

Provisional measures

(a) Judicial measures

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

During the proceedings or prior thereto, the following measures may be taken:

- Seizure of goods in sufficient quantity to guarantee the outcome of the proceedings;
- deposit or impoundment of objects, books, documents or papers relevant to the dispute;
- appointment of one or more inspectors;
- seizure of the object which is the subject of the claim; and
- prohibition on the performance of acts or contracts relating to the goods in dispute.

Article 165 of the Intellectual Property Law and Article 270 of the Code of Civil Procedure are applicable.

11. In what circumstances may such measures be ordered *inaudita altera parte*?

Given the nature of such measures, they are ordered without the opposing party being heard.

Anyone applying for a provisional measure must fulfil the following requirements:

- Prove that he/she is the right holder;
- post sufficient security to cover damages;
- provide the information necessary to identify the goods or services.

Article 165 of the Industrial Property Law and Articles 271 to 277 of the Code of Civil Procedure are applicable.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

Anyone applying for a provisional measure must show that the measure is necessary and that he/she is the right holder. He/she must also post sufficient security to meet any damage or injury caused.

Moreover, the party affected or the party against whom the measure is directed may request that the measure be lifted against security to cover the outcome of the proceedings.

Articles 1260 to 1272 of the Code of Civil Procedure are applicable.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

The duration and cost of proceedings vary according to the complexity of the case concerned.

(b) Administrative measures

14. Reply to the above questions in relation to any administrative provisional measures.

Describe the types of provisional measures that administrative authorities may order, and the legal basis for such authority.

In administrative declaration proceedings concerning the violation of many of the rights protected by the intellectual property laws, the Directorate General for Intellectual Property and the Directorate General of the National Agricultural Health Service (SENASA) may adopt the following measures:

- Order the withdrawal from circulation of the infringing goods;
- prohibit, with immediate effect, the marketing of products serving to violate any of the rights protected;
- order the seizure of goods;
- order suspension of service provision or closure of the establishment;
- indemnification of damage or injury sustained.

The applicable provisions are Articles 163 and 165 of the Industrial Property Law, Article 174 of the Law on Copyright and Article 46 of the Law on New Plant Varieties.

In what circumstances may such measures or precautionary measures be ordered *inaudita altera parte*. This is certainly legal.

Given the nature of such measures, they are ordered without the opposing party being heard.

Anyone applying for a provisional measure must fulfil the following requirements:

- Prove that he/she is the right holder;
- post sufficient security to cover damages;
- provide the information necessary to identify the goods or services.

Article 13 of the Code of Administrative Procedure is applicable.

Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

In order to initiate a provisional measure, the applicant must:

- Prove that he/she is the right holder;
- prove the existence of a violation of his/her right;

- prove that such violation is imminent;
- prove the existence of the possibility of sustaining irreparable injury;
- prove the existence of a justified fear that evidence may be destroyed, concealed, lost or altered;
- lodge sufficient security to cover damage or injury that might be caused to the person against whom the measure has been requested;
- provide the information necessary to identify the goods, services or establishment in or through which rights are being infringed.

The person against whom the measure has been taken may lodge an indemnity bond to cover damage or injury caused to the applicant, in order to have the measure lifted.

In deciding whether to implement the measure and in determining the amount of the security and the indemnity bond, the authority must take into account the seriousness of the infringement and the nature of the measure requested.

Article 65 of the Code of Administrative Procedure and Article 177 of the Law on Copyright are applicable.

Describe provisions governing the length and cost of proceedings

The length and cost of proceedings vary according to the complexity of the case concerned.

Special requirements related to border measures

15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

Any goods which infringe an intellectual property right may be detained at the borders by the national customs authorities, ex officio or at the request of the right holder.

Border measures are only applicable to imports. Goods in transit are not liable to detention by the customs authorities.

De minimis imports, as their name indicates, are considered to be of a personal nature and are not liable to detention by the customs authorities.

The applicable provisions are Articles 51 and 60 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, Articles 1 to 3 of the Customs Law, Article 163, paragraph 4, of the Industrial Property Law, and Article 174, paragraph 5, of the Law on Copyright and Related Rights.

16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?

Apart from the Agreement on Trade-Related Aspects of Intellectual Property Rights, the Honduran Executive Revenue Directorate (DEI) currently has available to it no laws or regulations governing procedures for the confiscation of goods infringing intellectual property rights.

Through the Executive Revenue Department (DEI), the Government is preparing a directive on border measures and provisional measures. This directive will contain the following provisions among others:

Anyone requesting border measures in respect of goods which allegedly infringe an intellectual property right must make a written submission to the Executive Revenue Department and/or the competent judicial authority (civil or criminal), providing proof of the following:

- His/her status as holder of the right allegedly violated;
- lodging of sufficient security to cover damages;
- provision of sufficient information to identify the goods allegedly infringing an intellectual property right;
- the name of the importer;
- a detailed description of the goods;
- the customs office through which the goods are to enter;
- likely date of entry of the goods;
- the warehouse where the goods are to be placed in storage at the disposal of the competent authority, which must be located within the territorial jurisdiction of the corresponding customs office; and
- the designation or express acceptance of the depositary.

When the customs authority has taken the necessary action, it shall inform the interested parties of the detention of the goods which shall be placed at their disposal in the warehouse designated for that purpose. In so doing, the customs authority shall draw up an official report including the following:

- Identification of the authority in charge of the procedure;
- description, nature and other characteristics of the goods;
- decision whereby suspension of the release into free circulation of the goods of foreign origin is ordered and notification thereof to the interested party; and
- the place where the goods are to be held at the disposal of the competent authority.

The person affected by implementation of the above-mentioned measures must respond within a period of 30 working days from the date of notification of the suspension, during which he/she submit appropriate evidence, pleas and grounds of defence in relation to the claim against him/her and may post an indemnity bond sufficient to cover any damage or injury that might be caused by the lifting of the measure concerned.

The competent authority shall give a final ruling on the border measures procedure and place the security, guarantee or indemnity bond at the disposal of the party in whose favour it has ruled.

17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

The length and cost of proceedings will depend on the complexity of the case. The person affected by suspension of the release of the goods into free circulation may post an indemnity bond to have the measure lifted. Otherwise it will be lifted in the final ruling made by the authority which determines the disposal of the goods.

18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to ex officio action?

Yes. The customs authorities may order a border measure ex officio or at the request of the right holder or an administrative or judicial authority, at the time of inspection of the goods.

The applicable provisions are Article 57 of the Customs Law and Article 58 of the Agreement on Trade-Related Aspects of Intellectual Property Rights.

19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

The competent authorities may adopt the following measures: fines, closure of establishments, suspension of release into free circulation, confiscation, seizure, destruction of the infringing goods and of materials used for their production, orders for damages, without prejudice to the penalties laid down in the Criminal Code and the Code of Civil Procedure.

In all matters relating to border measures, the applicable provisions are Articles 51 to 60 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, Articles 1 to 3 and 57 of the Customs Law, Article 163 of the Industrial Property Law, and Article 174, subparagraph 5, of the Law on Copyright and Related Rights.

Criminal procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.

- Ordinary criminal courts I, II, III, IV and V;
- Criminal magistrates' court;
- Criminal court;
- Police court;
- Court of Appeal;

- Supreme Court of Justice.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

Criminal procedures are available in respect of the rights protected by intellectual property laws:

- Industrial property: inventions and patent rights, utility models, industrial designs, distinctive signs, undisclosed information, marks, trade names, geographical indications and appellations of origin;
- copyright and related rights;
- legal protection of layout-designs of integrated circuits;
- protection of new varieties of plants.

Articles 248, 248a, 249, 251, 252 and 253 of the Criminal Code are applicable.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

The public authorities concerned are the same courts referred to in the reply to question 20.

In criminal matters, proceedings cannot be initiated ex officio.

The affected holder of an intellectual property right must lodge a complaint with the State prosecuting authority.

Complaints may be submitted in two forms:

- By application to the State prosecuting authority;
- by means of a private suit before a court.

The applicable provisions are Article 172 of the Industrial Property Law, Articles 173, 174 and 176 of the Law on Copyright and Related Rights, and Articles 248, 248a, 249, 251 and 253 of the Criminal Code.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

Yes. Any person who feels aggrieved.

Article 152 of the Code of Criminal Procedure applies.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **Imprisonment;**
- **monetary fines;**

- **seizure, forfeiture and destruction of infringing goods and material and implements for their production;**
- **other.**

Imprisonment and monetary fines

- Industrial property

The Criminal Code, in Chapter VIII, Articles 248, 259 and 253, provides that anyone who violates intellectual property rights shall be punishable by a fine of fifty thousand to one hundred thousand lempiras.

Articles 248, 251 and 252 of the Criminal Code lay down a penalty of three to six years' imprisonment applicable to anyone who falsifies, imitates or fraudulently uses any of the elements protected by industrial property legislation. Article 299 of the same code provides for a prison sentence of three to five years and a fine of fifty thousand to one hundred thousand lempiras applicable to anyone who commits acts of unfair competition as defined in Articles 660 to 690 of the Commercial Code and Article 249 of the Criminal Code.

Articles 167 to 169 and 171 of the Industrial Property Law provide for a fine of ten to two hundred units of the minimum wage, without prejudice to the penalties laid down in the Criminal Code, applicable to anyone who wilfully carries out an act of unfair competition relating to any aspect of industrial property.

Articles 73 to 78 and 170 to 173 of the Industrial Property Law contain provisions relating to the protection of industrial secrets. Article 171 provides that anyone who discloses such information shall be liable to a fine of 10 to 200 units of the minimum wage. Article 214 of the Criminal Code provides that anyone who appropriates papers belonging to others in order to discover their secrets shall be liable to a term of imprisonment of six to eight years in the case of private individuals and of eight to twelve years in the case of public officials. Article 215 of the same code provides that a term of imprisonment of three to six years shall be incurred by anyone who reveals without just cause or uses for his/her own benefit or that of others a secret learned by virtue of position or employment, if injury is caused thereby to another person.

- Copyright and related rights

Articles 156 to 180 of the Law on Copyright lay down administrative, criminal and civil procedures and establish a monetary fine for violations of such rights in the amount of ten to two hundred units of the minimum wage, without prejudice to criminal penalties and penalties for economic damage and injury caused by the perpetrator's fraudulent action.

Seizure, forfeiture and destruction of infringing goods and materials and implements for their production

Article 177 of the Law on Copyright and Related Rights provides that, in order for seizure, prohibition or suspension to be applicable, the corresponding criminal proceedings must have been instituted.

Article 169 of the Industrial Property Law provides that products displaying unlawful distinctive signs, advertising material referring to such signs and any material or instruments used specifically to commit an offence, shall be held or seized by the competent authority (public prosecutor's office, criminal court) pending the outcome of the corresponding proceedings.

2. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

Criminal proceedings are conducted in two stages: summary and plenary.

Summary: this stage has a duration of one month from the time of submission of the complaint.

Plenary: the duration is determined at the request of a party.

Cost of proceedings: the cost of criminal proceedings depends on the complexity of the case concerned.

The applicable provisions are Article 174 of the Code of Criminal Procedure, Circular 20 of the Supreme Court of Justice and Article 251 of the Code of Criminal Procedure.
